

REMARKS

Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and following remarks.

Election/Restrictions

1. Reconsideration of the finalization of the restriction requirement made on page 2 of the Office Action is respectfully requested. The Examiner notes that "Applicant fails to distinctly and specifically point out any supposed error regarding the alternative co-extrusion method in the restriction requirement, i.e., merely stating 'no substantial example' is insufficient to overcome the restriction requirement." In response thereto, applicant maintains that co-extrusion is not part of applicant's invention nor is it alluded to or even speculated upon in applicant's specification. The concept of co-extrusion of applicant's product is one that has been raised by the Examiner, and any possibility that the instantly claimed product can be obtained by a co-extrusion process is one that must be substantiated by the Examiner, not applicant. It is applicant's duty to adequately describe what his invention is, and this has been fulfilled by the present specification. He is not in a position to comment, nor is he required to speculate, on other possible inventions especially when those inventions are not substantiated or presented to him by way of an example or illustration. It would therefore be impossible for applicant "to distinctly and specifically point out any supposed error" regarding a supposed "alternative co-extrusion method" when the alternative extrusion method exists only conceptually, or at the very least has not been made part of the file record.

Suffice it to say, a unity of invention exists between the product and process claims, and their similarities justify maintaining these claims in one national application. Both the product and process claims are concerned with the deposition of a primary, film-forming layer on a porous polyurethane resin substrate characterized in that the

primary layer comprises at least one -OH reactive group in its non-aqueous, dry state. The only clear standard for dividing an application into two inventions is whether the inventions are independent and distinct. In this regard, independent inventions are defined as inventions that are reasonably assumed to lack unity of invention, and distinct inventions are defined as inventions that are reasonably assumed to be patentably distinct.¹ The provisions of 37 C.F.R. 1.141(a)² require that the inventions in question be both independent and distinct in order for them to be divided. Since the instant product and process claims possess unity of invention, their restriction is urged not to be proper under the Code of Federal Regulations. Withdrawal of the restriction requirement between Groups I and II is once again respectfully requested.

2. With regard to new claims 110-112, this will confirm that in a telephone conference between the Examiner and the undersigned on May 9, 2005, species claim 111 (directed to a “water-based polyurethane paint”) was provisionally elected over claim 112 (directed to a “solvent based polyurethane paint”) in response to the Examiner’s Species Group II restriction requirement contained on page 3 of the February 9, 2005 Office Action.

3. In addition, and pursuant to a telephone call from the Examiner on May 23, 2005, the undersigned authorized the classification of claim 109 under the process group of claims (Group I) which now stand as being withdrawn. In the same telephone call, the undersigned agreed to an Examiner’s Amendment to the preamble of claims 102-108

¹ See p. 595 of the article entitled “Ten Misconceptions of Division of Inventions for Examination Purposes” by Jon W. Henry appearing in JPOS, Vol. 86, No. 8 (August, 2004).

² § 1.141 Different inventions in one national application.

(a) Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

by deleting the phrase “method or.” This amendment to claims 102-108 is reflected in the presentation of those claims in this response along with claims 1-101 and 109-112.

It is noted that claim 102 is an elected Species I claim along with the other provisionally elected claims 52-57, 78-81, 104-108 and 110-111. The omission of this claim from the itemization contained in box 6 on the Office Action Summary of the Office Action is requested to be included as those claims presently in the application.

Claim Rejections Under 35 USC § 112; Non-elected Species Claims

Independent claims 52 and 78 have been amended to more adequately define the invention under the first and second paragraphs of 35 U.S.C. § 112. In particular, amended claim 52 further clarifies that the coating on the porous polyurethane product is in its finished state, i.e., the primary layer appearing on the resin substrate is in its non-aqueous dry state (after an aqueous solution of the primary layer compound has been applied to the substrate and allowed to substantially dry), and overlain by the secondary layer. Claim 78 has been amended in similar fashion to more adequately define the film-forming layer on the substrate in its dry state. Support is found in the specification at page 10, lines 9-24; page 12, lines 18-23; page 17, line 28 to page 18, line 12; page 18, lines 14-18 and 23-25; page 40, lines 16-21, and in Examples 3-18. Thus, the coating of claim 52 comprises a primary and secondary layer with the secondary layer overlying and interacting with the primary when the primary layer is in its non-aqueous dry state. Similarly, the film-forming layer of claim 78 comprises “a compound that includes at least one -OH reactive group in its non-aqueous dry state.”

In addition, and in order to provide language consistency between amended claim 52 and its corresponding dependent claims, dependent claims 54, 58, 61, 64, 67, 70, 73 and 76 have been amended to respectively identify the primary layer as comprising the specific species compounds identified therein. Claims 55, 59, 62, 65, 68, 71, 74 and 77,

which are dependent on respective claims 54, 58, 61, 64, 67, 70, 73 and 76, are directed to the weight percentage ranges of the species compound in solution from which the primary layer is prepared, thus providing an adequate framework for describing the amount of primary layer that is disposed on the porous polyurethane resin substrate. In like manner, dependent claims 80, 82, 85, 88, 91, 94, 97 and 100 have been amended to identify the film-forming layer of claim 78 as comprising the species compounds identified in the corresponding dependent claims. Similarly, claims 81, 83, 86, 89, 92, 95, 98 and 101, which are dependent on respective claims 80, 82, 85, 88, 91, 94, 97 and 100, are directed to the weight percentage ranges of the respective species compounds in solution from which the film-forming layer is prepared.

In view of the foregoing claim amendments, it is submitted that any concerns the Examiner may have regarding the description of the coating on applicant's porous polyurethane product are overcome and that the product claims adequately describe applicant's product within the meaning of the first and second paragraphs of 35 U.S.C. § 112. Withdrawal of the objections to the claims are therefore respectfully requested. If any outstanding issues remain regarding the claims in the present application, the Examiner is respectfully requested to telephone the undersigned to resolve any such issues.

With the amendments made to independent claims 52 and 78, it is respectfully submitted that the application is in condition for immediate allowance. With two allowable generic claims being present in the application, and in accordance with the provisions of 37 C.F.R. § 1.141(a), it is respectfully requested that non-elected species claims 58-77, 82-101 and 112, be rejoined with the elected species claims 54-57, 81, 102, 104 and 111. In order to accommodate the amendments made to the non-elected and withdrawn species claims (so as to provide language consistency in view of the amendments made to their respective independent claims 52 and 78), they have been identified as being "withdrawn and currently amended." This notation was indicated as

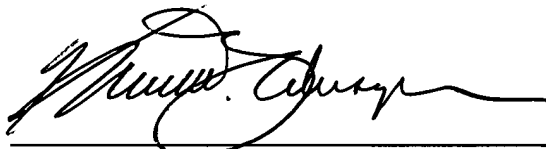
being acceptable to Examiner Chang in a telephone conversation with the undersigned on June 14, 2005.

The prior art of record.

With regard to paragraph 8 (page 5) of the May 26, 2005 Office Action, applicant acknowledges that the prior art made of record is not being relied upon to reject any of the present claims. The citation of DD 136589A as being of interest is also acknowledged and applicant agrees that it is not a proper basis for denying patentability to the instant claims.

In view of the foregoing amendments and remarks, the rejoinder of non-elected species claims 58-77, 82-101, 103 and 112 to the application, as well as process claims 1-51 and 109, and the allowance of these claims with elected claims 52-57, 78-81, 102, 104-108 and 110-111, are earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Kenneth F. Dusyn', written over a horizontal line.

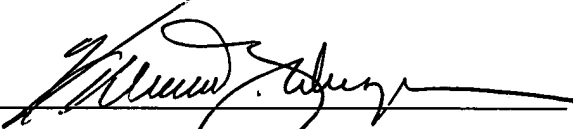
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CERTIFICATE OF MAILING

The undersigned hereby certifies that this correspondence and its accompanying enclosures are being deposited with the United States Postal Service as "First Class Mail" in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 1st day of July, 2005.


Kenneth F. Dusyn